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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,314	10/02/2003	Wolfgang Wuttke	20213-81002	2023
7590 06/18/2004			EXAMINER	
SIDLEY AUSTIN BROWN & WOOD LLP			DENTZ, BERNARD I	
555 West Fifth Street			ART UNIT	
Los Angeles, CA 90013-1010			PAPER NUMBER	
			1625	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/676,314

**Applicant(s)**

WUTTKE ET AL.

**Examiner**

Bernard Dentz

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Restriction to one of the following inventions is required under 35 U.S.C.

121: The method of use corresponding to the active ingredient is grouped with the active ingredient.

- I. Claims 1-5, 9 and 12-14 drawn to "drugs"(can't tell whether compound or composition is intended) of formula (I) where ring A or B is substituted with an OX or a keto group , classified in class 568, subclass 374.
- II. Claims 1 and 12-14, drawn to "drugs" of formula I where position 17,18,19,and 20 is substituted by an OX radical, classified in class 568, subclass 819.
- III. Claims 1 and 12-14, drawn to drugs of formula I, where at least 1 CH<sub>3</sub> group at position 17-20 is replaced by a COOH gp., classified in class 562, subclass 501.
- IV. Claims 1, 6-8 and 12-14 drawn to drugs of formula II substituted as in Gp. I above, classified in class 549, subclass 498.
- V. Claims 1 and 12-14, drawn to drugs of formula II substituted as in Gp. II above, classified in class 549, subclass 497.
- VI. Claims 1 and 12-14, drawn to drugs of formula II substituted as in Gp. III above, classified in class 549, subclass 499.
- VII. Claims 10-14, drawn to drugs of claims 10 and 11 which contain a lactone ring, classified in class 549, subclass 323.

VIII. Claims 15-17, drawn to a method of treatment comprising use of a prolactin lowering compound selected from rotundifuran, sclareol and solidagenon, classified in class 514, subclass 729.

The inventions are distinct, each from the other because: Claim 1 drawn to the active ingredient contains many possible variations close to a host of known compounds as can be seen from the exclusions at the end of said claim. The actual intended scope is unclear. Does claim 1 include compounds where structural formulae I and II are unsubstituted and don't contain an optional double bond. There are quite structurally distinct variations within claim 1. Also note that the compounds of claims 10 and 11 do not fall within claim 1.

Restriction is proper for the above reasons and because the searches for the different embodiments are not coextensive.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8 to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on 571 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dentz

6-15-2004



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